

REMARKS

Applicants thank the Examiner for the courtesy extended to Applicants' attorney during the interview held February 6, 2004, in the above-identified application. During the interview, Applicants' attorney explained the presently-claimed invention and why it is patentable over the applied prior art, and discussed other issues raised in the Office action. The discussion is summarized and expanded upon below.

The rejection of Claims 21-24 under 35 U.S.C. § 103(a) as unpatentable over U.S. 5,420,351 (Suzuki et al), is respectfully traversed. The Examiner finds that the adamantane derivative represented by any of chemical formulae (a1) to (a3) is a position isomer of Suzuki et al's adamantane derivatives. In reply, while the presently-recited compounds are inclusive of alkyl substitution on the **phenylene** rings, Suzuki et al's derivatives optionally contain alkyl substitution on **outer phenyl** rings. However, merely because certain compounds may be position isomers of other compounds does not mean that **any and all** position isomers of known compounds are *prima facie* obvious. The Examiner cites *In re Wilder*, 195 USPQ 426 (CCPA 1977) in support. In reply, *Wilder* does not support the Examiner. In *Wilder*, the prior art disclosed a genus, of which the claimed compound was a species, as well as a homologue and a structural isomer (1-methylhexyl isomer) of the claimed compound (1,4-dimethylamyl isomer). Thus, in *Wilder*, the prior art was much closer to the claimed invention than herein. Applicants describe, in the specification beginning at page 31, line 24, the following:

By introducing substituents in R1 through R8, heat endurance and endurance improve compared to a case without the substituents. By introducing the substituents, rotations around the connecting axes between the adamantane and benzene ring and between the benzene ring and substituent molecule are constrained, resulting in decrease in the movability of the molecule and thus improvements in heat endurance.

In Suzuki et al, because there are no phenylene-substituted groups, rotation occurs rather easily and thermal endurance would therefore be low. Moreover, because the electron density is too high, although the derivative could be used as a hole transport material, it would not be suitable as an emissive material or as an electron transport material.

Clearly, one skilled in the art reading Suzuki et al would not be apprised of the advantages derived from such phenylene ring substitution. Cases such as *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992), cited in the previous response, are still apt.

Nevertheless, in order to advance the prosecution, the subject matter of these claims has been omitted from the newly-submitted claims.

For all the above reasons, it is respectfully requested that the rejection over Suzuki et al be withdrawn.

The rejection of Claims 20, 22-24, and 26-28 under 35 U.S.C. § 112, first paragraph, as failing to satisfy the description requirement thereof, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that it be withdrawn.

The rejection of Claims 18-20 and 26-28 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that it be withdrawn.

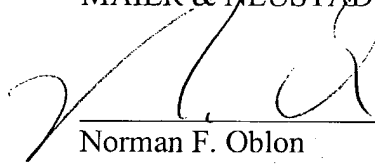
The various objections to the disclosure and the claims are now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that they be withdrawn.

Applicants gratefully acknowledge the Examiner's allowance of Claim 29 and the indication of allowability of Claims 25 and 30-33. Nevertheless, Applicants respectfully submit that all of the presently-pending claims in this application are now in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

If the Examiner determines that the present amendment raises new issues and/or does not put the application in condition for allowance, she is requested to telephone the undersigned attorney, so that a further amendment can be made to put the application in condition for allowance.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)
NFO/HAP/cja

Harris A. Pitlick
Registration No. 38,779